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In re Application of :
JOYCE et al. : DECISION ON
Application No.: 09/380,189 :
PCT No.: PCT/AU98/00127 : PETITION
Int. Filing Date: 26 February 1998 :
Priority Date: 26 February 1997 :
Attorney Docket No.: 070-011 :
For: COMBINED LIGHT SOURCE AND AIR :
PURIFIER :
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This decision is in response to the submission filed 26 February 2001 which included, *inter alia*, a PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b), a declaration signed by three of the four joint inventors, and a STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. 1.47).

BACKGROUND

On 26 February 1998, applicant filed international application No. PCT/AU98/00127 which claimed a priority date of 26 February 1997, and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 03 September 1998. A Demand for international preliminary examination in which the United States was elected, was filed on 28 September 1998, prior to the expiration of nineteen months from the priority date (26 September 1998 being a Saturday). Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 August 1999.

On 26 August 1999, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States under 35 U.S.C. 371 along with, *inter alia*, the U.S. basic national fee and a declaration of inventors executed by two of the four joint inventors.

On 08 December 1999, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that

an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. This notification set a one-month extendable period for reply.

On 08 August 2000, the USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 08 December 1999 within the time period set therein.

On 26 February 2001, applicant submitted the instant PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) along with a declaration signed by three of the four joint inventors and a STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. 1.47).

DISCUSSION

The STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NONSIGNING INVENTOR filed 26 February 2001, the declaration signed by three of the four joint inventors filed 26 February 2001, and the authorization to charge fees under 37 CFR 1.17 to Deposit Account No. 03-1723 in the Transmittal letter filed 26 August 1999 is construed as a petition under 37 CFR 1.47(a).

Petition Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), a petition under 37 CFR 1.47(a) was filed 26 February 2001, which is a proper reply.

As to item (2), the petition fee of \$620.00 for a small entity was also submitted on 26 February 2001.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the fee of \$130.00 has been charged to Deposit Account No 03-1723. Items (3) and (4) have been satisfied as well.

As to item (2), the statement of facts by Glenda Joyce suggests that Mr. Wynne-Jones cannot be reached after diligent effort. MPEP § 409.03(d) states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

It is noted that the statement of facts by Glenda Joyce is not an affidavit or a declaration. It is also noted that no copies of documentary evidence such as a certified mail return receipt have been provided to support a finding that Mr. Wynne-Jones could not be reached. It is not clear that anyone has even attempted to contact Mr. Wynne-Jones at his last known address. Nor is it clear why it is believed that Mr. Wynne-Jones left Australia. It is also noted that the statements made in the statement of facts by Glenda Joyce regarding the activities and knowledge of Stephen John Joyce and Brett Alan Sarghi are hearsay. As noted above, the affidavit or declaration of facts must be signed by a person having firsthand knowledge of the facts recited therein.

If applicants are attempting to establish a refusal of the non-signing inventor to execute the application, attention is directed to MPEP § 409.03(d).

The surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date has been charged to Deposit Account No. 03-1723, as authorized in the Transmittal Letter filed 26 August 1999.

CONCLUSION

The petition under 37 CFR 1.137(b) is GRANTED for the reasons set forth above.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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